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OFFICE OF PETITIONS

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

In re Application of :
Goel, et al. :
Application No. 10/675,140 : ON APPLICATION FOR
Filed: September 30, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 0492311-0482 :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed September 10, 2009. Applicants submit that the patent term adjustment to be indicated on the patent is fifty-six (56) days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the

initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on July 11, 2007.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **granted to the extent indicated herein.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance is zero (0) days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On June 12, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. Applicants timely filed the instant application for patent term adjustment².

Applicants dispute the reduction to the patent term adjustment of 237 days entered pursuant to 37 CFR 1.704(b) for failure to respond to a notice purportedly mailed December 24, 2003. Specifically, applicants states that:

The second delay with which Applicants take exception is the Applicant delay of 237 days shown extending from December 24, 2003 to November 16, 2004. There is no record of a Notice being mailed to Applicants on December 24, 2003, in the file history. The Notice was mailed November 17, 2004 to which Applicant timely responded. Applicants request that the delay of 237 days be cancelled for lack of bases in the prosecution history.

Excerpt taken from "Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b)", filed September 10, 2009, p. 2.

² The issue fee was paid on September 11, 2009. Accordingly, applicant timely filed the instant request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.704(b) prior to the payment of the fee set forth in 37 CFR 1.18(e).

Applicants' argument has been considered and is well taken. A review of the Image File Wrapper (IFW) history for this application does not reveal a notice as being mailed to applicants on December 24, 2003. Thus, in this instance, applicants did not fail to engage in reasonable efforts to conclude processing such that entry of a reduction to the patent term adjustment under 37 CFR 1.704(b) would be warranted. Accordingly, the period of reduction of 237 days is being removed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to the patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Wednesday

PALM INTRANET

Date: 12/2/2009

Time: 14:08:56

PTA Calculations for Application: 10/675140

Application Filing Date:	09/30/2003	PTO Delay (PTO):	318
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	693
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	237		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
106	12/02/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	237		
95	06/12/2009	MAIL NOTICE OF ALLOWANCE			
94	06/08/2009	ISSUE REVISION COMPLETED			
93	06/08/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
92	06/08/2009	CASE DOCKETED TO EXAMINER IN GAU			
87	06/06/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
86	06/06/2009	DOCUMENT VERIFICATION			
85	06/06/2009	NOTICE OF ALLOWABILITY			
84	04/24/2009	DATE FORWARDED TO EXAMINER			
83	04/03/2009	RESPONSE AFTER NON-FINAL ACTION			
82	03/05/2009	ELECTRONIC REVIEW			
81	03/05/2009	EMAIL NOTIFICATION			
80	03/05/2009	MAIL NON-FINAL REJECTION			
79	03/02/2009	NON-FINAL REJECTION			
78	12/22/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
77	12/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
76	12/30/2008	DATE FORWARDED TO EXAMINER			
75	12/22/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
74	12/30/2008	DATE FORWARDED TO EXAMINER			
73	12/22/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		62	63
72	12/30/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			

71	12/22/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
70	12/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
69	12/22/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
68	12/15/2008	EMAIL NOTIFICATION			
67	12/15/2008	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
66	12/04/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
65	07/22/2008	ELECTRONIC REVIEW			
64	07/21/2008	EMAIL NOTIFICATION			
63	07/21/2008	MAIL FINAL REJECTION (PTOL - 326)			
62	07/16/2008	FINAL REJECTION			
61	04/11/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
60	05/09/2008	DATE FORWARDED TO EXAMINER			
59	04/11/2008	RESPONSE AFTER NON-FINAL ACTION		91	55
58	04/11/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
57	04/11/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
56	04/11/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
55	10/11/2007	MAIL NON-FINAL REJECTION			
54	10/05/2007	CASE DOCKETED TO EXAMINER IN GAU			
53	09/27/2007	NON-FINAL REJECTION			
52	07/18/2007	DATE FORWARDED TO EXAMINER			
51	07/11/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
50	07/18/2007	DATE FORWARDED TO EXAMINER			
49	07/11/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		90	43
48	07/18/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
47	07/11/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
46	07/11/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
44	07/11/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
43	01/12/2007	MAIL FINAL REJECTION (PTOL - 326)			

42	01/08/2007	FINAL REJECTION			
41	11/10/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
40	11/10/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
39	11/22/2006	CASE DOCKETED TO EXAMINER IN GAU			
38	11/03/2006	DATE FORWARDED TO EXAMINER			
37	09/29/2006	RESPONSE AFTER NON-FINAL ACTION		213	33
36	09/29/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
35	06/08/2006	PETITION ENTERED			
34	06/08/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	11/29/2005	MAIL NON-FINAL REJECTION			
32	11/25/2005	NON-FINAL REJECTION			
31.7	11/10/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	29
31	11/10/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	11/17/2005	DATE FORWARDED TO EXAMINER			
29	11/10/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
28	10/14/2005	MAIL RESTRICTION REQUIREMENT	318		-1
27	10/13/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
26	10/06/2005	CORRESPONDENCE ADDRESS CHANGE			
25	09/19/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
24.7	11/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	11/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	09/19/2005	CASE DOCKETED TO EXAMINER IN GAU			
22	01/14/2005	MISCELLANEOUS INCOMING LETTER			
21	02/14/2005	CORRESPONDENCE ADDRESS CHANGE			
20	01/21/2005	APPLICATION RETURN FROM OIPE			
19	01/21/2005	APPLICATION IS NOW COMPLETE			
18	01/21/2005	APPLICATION RETURN TO OIPE			
17	01/21/2005	APPLICATION RETURN FROM OIPE			
16	01/21/2005	APPLICATION RETURN TO OIPE			
15	01/21/2005	APPLICATION DISPATCHED FROM OIPE			
14	01/21/2005	APPLICATION IS NOW COMPLETE			

13	01/07/2005	ADDITIONAL APPLICATION FILING FEES			
12	01/07/2005	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
11	11/17/2004	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
9	12/24/2003	PRE-EXAM OFFICE ACTION WITHDRAWN			
8	11/16/2004	ADDITIONAL APPLICATION FILING FEES		237	6
7	11/16/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	12/24/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
4	12/13/2003	CASE CLASSIFIED BY OIPE			
3	12/13/2003	CLEARED BY OIPE CSR			
2	12/02/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	09/30/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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